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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,639	02/13/2001	Francis J. Bensus	31599/200998	2775

826 7590 12/04/2002

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EXAMINER

MIGGINS, MICHAEL C

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/782,639

Applicant(s)

BENSUR, FRANCIS J.

Examin r

Michael C. Miggins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-3. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 6 and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1 and 6 are not enabled because one of ordinary skill in the art would not be able to prepare and/or use the invention as disclosed because the specification does not provide any guidance as to how one of ordinary skill in the art would prepare "... a layer of metallized polyester ...". The specification does not indicate what types of metals are to be used (eg. Aluminum, Silicon or oxides thereof). In addition, the specification does not disclose a method for making "... a layer of metallized polyester ..." (eg. is the polyester impregnated with a metal, is a metal deposited on the polyester?). Because the instant disclosure does not provide what types of materials are used to metallize or how the polyester is metallized, claims 1 and 6 are not enabled. For the purposes of examination the limitation "... a layer of metallized polyester ..." is interpreted as meaning any polyester with a metal or metal containing compound in which the polyester is impregnated with a metal or metal containing compound or wherein a metal or metal containing compound is deposited on the polyester.

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Claim 9 is not enabled because it recites the limitation "... a retortable lacquer ...". One of ordinary skill in the art would not know how to prepare said lacquer because applicant does not describe what lacquers (ie. What compounds are to be used as lacquer) are to be used or a method for preparing the lacquer. Because the instant disclosure does not provide what types of materials are used as a lacquer or how to prepare the lacquer, claims 1 and 6 are not enabled.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "metallized" in claims 1 and 6 is a relative term which renders the claim indefinite. The term "metallized" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The current disclosure provides no information as to the scope of the term metallized (ie. what metals or metal containing compounds are used, or how much metal or metal containing compound is used, or how is the polyester metallized, is the polyester impregnated with a metal or metal containing compound or is a metal or metal containing compound deposited on the polyester. For the purposes of examination the limitation "... a layer of metallized polyester ..." is interpreted as meaning any polyester

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with a metal or metal containing compound in which the polyester is impregnated with a metal or metal containing compound or wherein a metal or metal containing compound is deposited on the polyester.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kunz et al. (U.S. Patent No. 5,387,440).

Kunz et al. teach a flexible non-foil-based retort packaging structure (abstract, column 7, line 36 through column 9, line 26), comprising a layer of metallized polyester (since a ceramic oxide, aluminum or silicon oxide is deposited on a polyester, see column 2, lines 1-68 and column 5, lines 1-40), a layer of polyester laminated to one side of the layer of metallized polyester (column 2, lines 1-68 and column 5, lines 1-40) and a layer of cast polypropylene laminated to an opposite side of the layer of metallized polyester (column 2, lines 1-68 and column 3, lines 14-32), wherein the layers are laminated to one another using solvent-based retortable laminating adhesives (column 5, line 46 through column 6, lines 1-35), wherein layers are laminated to one another using solventless retortable laminating adhesives (column 5, line 40 through column 6, lines 1-35), wherein the polyester layers comprise

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polyethylene terephthalate and comprising at least two opposing portions having peripheral edge portions of the opposing portions heat-sealed together so as to form a pouch (column 7, line 36 through column 9, line 26) (applies to instant claims 1-3, 5-8 and 10-12).

Claims 4 and 9 recite the limitations "... wherein the layer of polyester is printed with ink on the side of the layer of polyester that faces the layer of metallized polyester ..." and "... wherein the layer of polyester is printed with ink on an opposite side thereof from the layer of cast polypropylene and the ink is then covered with a layer of a retortable lacquer ..." respectively, said limitations are method limitations in a product claim which are not germane to the patentability of the product in a product claim. Therefore both limitations have been given little to no patentable weight (applies to instant claims 4 and 9).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. JP No. 03244535 (copy of English abstract provided by applicant) and Moteki et al. (U.S. Patent No. 5,756,171) are cited for teaching multi-layer laminates containing polyester.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is (703) 305-0915. The examiner can normally be reached on Monday-Friday; 1:30-10:00 PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

MCM

December 2, 2002


NASSER AHMAD
PRIMARY EXAMINER
Acting SPE